

DETAILED ACTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-17 and 19-21, drawn to a method and apparatus for expanding the capacity of a fixed digital field by calculating a first and second unique number, and assigning a first or second meaning to a particular combination of bits in the digital field based on whether the first or second unique number present in a unique number field.
 - II. Claims 16-18, drawn to a method and apparatus for expanding the capacity of a fixed digital field by determining if fill bits have a value other than a designated fill value, and if said fill bits have a value other than said designated fill value, assigning a different meaning to the combination of bits in said fixed digital field based on the value of said fill bits.
2. The inventions are clearly different and distinct from each other, and because there would be a burden on the examiner to search and exam both Group of inventions, restriction for examination purposes as indicated is proper.
3. During a telephone conversation with applicant's representative, Brian M. Berliner, on 03/13/2008, a provisional election was made without traverse to prosecute the invention of Group I, claims 1-17 and 19-21. Affirmation of this election must be made by applicant in

Art Unit: 2193

replying to this Office action. Claims 18 and 22 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

5. Claims 19-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 19, the recitation "the method of claim 16", line 1, is indefinite since claim 16 is directed to an apparatus. Further, "said fill bits", line 2, "the values of remaining ones", lines 2-3, and "said transmission packet", line 3, lack proper antecedent basis. Claims 20 and 21 also have the same problems.

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-3,6-13,16,17 and 19-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-3,6-13,16,17 and 19-21 are directed an invention that merely performs calculations and manipulations of data. In order for such a claimed invention that merely performs calculations and manipulations of data to be statutory, the claimed invention must accomplish a practical application, and is not directed to a preemption of a calculation and/or manipulation data . That is the claimed invention must transform an article or physical object to a different state or thing, or produce a useful, concrete and tangible result and not cover every substantial practical application . See State Street 47 USPQ2d, Benson 175 USPQ , and “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility”, OG Notices: 22 November 2005. It is clear from claims 1-3,6-13,16,17 and 19-21 that the claimed invention merely performs calculation of data. They do not transform an article or physical object to a different state or thing. Further, since the claim fails to recite a practical application for the calculation of the claimed invention, the result produced by the invention as recited in the claims invention does not have a real world value and thus is not useful, concrete and tangible. Therefore, claims 1-11 are directed to non-statutory subject matter as the claimed invention fails to accomplish a practical application. Further, since the claims appear to cover every substantial practical application, they are also directed to a preemption of the claimed manipulations and calculations of data in any and every practical application.

8. Claims 4 and 5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Claims 14 and 15 are allowed.
10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chuong D. Ngo whose telephone number is (571) 272-3731. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lewis, Jr. A. Bullock can be reached on (571) 272-3759. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Chuong D Ngo/
Primary Examiner, Art Unit 2193

03/14/2008